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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,933	04/09/2001	Rainer K. Schmid	032004-005	6673

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EXAMINER

MOHANDESI, JILA M

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 05/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/827,933

Applicant(s)

SCHMID, RAINER K.

Examiner

Jila M. Mohandesi

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/09/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

*N*

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of layers of Carbon graphite **23** must be shown or the feature(s) canceled from the claim (11). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

*2* 1. The disclosure is objected to because of the following informalities: On page 7, line 7, "upper portion **14**" appears to be --upper portion **12**--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

*3* 2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

*4* 3. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It appears that claim 19 should depend from claim 18 instead of claim 16 to provide proper antecedent basis for the claim.

***Claim Rejections - 35 USC § 102***

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- 5 A. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 6 B. Claims 1, 7-8, 14, 18-19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Beyl (5,282,325). Beyl `325 discloses an article of footwear comprising: an upper; an outsole defining a ground engaging surface; a sole disposed between said upper and said outsole, said sole including an energy return system; wherein said energy return system comprises a first rigid plate (2), a second rigid plate (3) spaced a predetermined distance from first rigid plate, and at least one separating element (R) disposed therebetween to maintain the spacing between said plates. .

- 7 C. Claims 1, 6-8, 12, 18-19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sabol (5,343,636). Sabol `636 discloses an article of footwear comprising: an upper; an outsole (121, 122) defining a ground engaging surface; a sole disposed between said upper and said outsole, said sole including an energy return system; wherein said energy return system comprises a first rigid plate (11), a second rigid plate (12) spaced a predetermined distance from first rigid plate, and at least one separating element (13) disposed therebetween to maintain the spacing between said plates. See Figures 1, 2b and 3a embodiments.

With respect to claim 6, see the separating element of Fig 3a.

***Claim Rejections - 35 USC § 103***

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8 7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9 8. Claims 2-3, 9-11, 12-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyl `325 in view of Schmid (4,858,338). Beyl `325 as described above discloses all the limitations of the claims except for the specifics of the material of the rigid plates. Schmid `338 discloses an insert/sole (20) for a an article of footwear where the insert/sole absorbs, stores and returns the kinetic energy of a wearer to the wearer's foot. The insert/sole (20) is made of an elastic material which is defined as a high tensile strength material which has a modulus of elasticity of at least  $32 \times 10^6 \text{ lb/in}^2$  made of a plurality of Graphite fibers. Graphite fibers have the advantages that they have a high tensile strength, a high modulus of elasticity, are lightweight, and can be easily processed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rigid plates of Beyl `325 from plurality of Graphite fibers as taught by Schmid `338 to enhance the energy return properties of the energy return system. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 13, the insert/sole of Schmid ` 338 discloses a rocker bottom (28) to cradle the first metatarsal head of the foot of the wearer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was

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made to provide a rocker bottom to the first and second rigid plates of Beyl `325 as taught by Schmid `338 to better cradle the foot of the wearer.

With respect to claims 12 and 15 which further limits the size of the rigid plates, it would have been obvious to one having ordinary skill in the art to modify and/or alter the size of the rigid plates in order to make the article of footwear more energy efficient and/or as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well in any of a variety of sizes.

¶ 9. Claims 4-5, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sabol `636.

With respect to claims 4 and 16 which further limit the material of the separating element (13), it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the material of the separating element since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claims 5 and 17, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide two separating elements instead of one in the energy return system of Sabol `636 to enhance the energy return system, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

### ***Conclusion***

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11 10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are footwears with energy return systems analogous to applicant's invention.

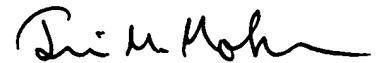
12 11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is 703-305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

**J. Mohandesi**  
**Patent Examiner**

Jila M. Mohandesi  
Examiner  
Art Unit 3728



JMM  
May 1, 2002